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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/535,734

11/03/2005

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123992

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EXAMINER

KNABLE, GEOFFREY L

ART UNIT

PAPER NUMBER

1791

NOTIFICATION DATE

DELIVERY MODE

05/28/2010

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

OfficeAction25944@oliff.com  
jarmstrong@oliff.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/535,734	<b>Applicant(s)</b> NAKADA ET AL.	
	<b>Examiner</b> Geoffrey L. Knable	<b>Art Unit</b> 1791	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 01 February 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>4/26/2010</u> . | 6) <input type="checkbox"/> Other: _____  |

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1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1-12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 1 has been amended to define that the method further comprises measuring radial run-out of the toroidally expanded carcass band “to adjust a position of the carcass band and the bead cores such that a phase  $f$  of a primary harmonic component and an amplitude  $Y$  of the waveform are cancelled out”. It however is not understood how measuring “adjusts” a position, especially as, when toroidally expanded, the carcass band is already assembled with the bead cores and is seemingly not susceptible to easy adjustment. It therefore is not understood how the method is practiced and how as claimed it could cancel out the waveform. The invention is therefore not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention without an undue burden of experimentation and/or speculation. The artisan is left to speculate on what is to be adjusted and/or how it specifically is to be adjusted and how the specific amounts of adjustment are determined and the specification does not provide sufficient further detail in this regard to guide the artisan in specifically how this method is to be practiced.

Claim 10 defines measuring the radial run-out of a first green tire and “using a result thus measured to control the setting position or the angle of the bead core...” To the extent that this method can be practiced simply using a result of a RRO measurement to control setting position, this is not described sufficiently to practice the invention without an undue burden or experimentation and/or speculation. Although there is mention of determining a “correlation”, it is not clear how or where it is further used in the method, or even specifically how this is to be determined.

3. Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In the added clause to the last 8 lines of claim 1, the scope of the claimed method is not understood as it is not clear how measuring run-out of the toroidally shaped carcass band adjusts a position of the carcass band/bead core as they are already assembled when this measurement takes place.

In claim 10, it is still not clear how or whether the claimed determining a correlation step is further used in the method as at present there is no further reference to using this correlation in any manner.

4. Claims 1, 3-5, 7-9, 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 448,407 to Yamakawa et al. taken in view of Okada et al. (US 2001/0002608) and at least one of [Tanaka et al. (US 6,514,441 - newly applied) and Sakamoto et al. (US 5,882,452 - newly cited)].

EP '407 and Okada et al. are applied for the same reasons as set forth in the last office action. As to the new language added to the end of claim 1, as already noted, the scope of this requirement is somewhat difficult to ascertain and compare with the prior art as it is not clear how measuring a toroidally shaped carcass band adjusts or even allows adjustment of a position as claimed. In any event, Tanaka et al. (e.g. fig. 2) and Sakamoto et al. (e.g. note block 15 in figs. 1/10/13 and especially the canceling out shown in fig. 14) each teach measuring the run-out of a green tire during tire manufacture, a green tire being a toroidally expanded carcass, and carrying out further adjustments based on this measurement to help minimize and thus cancel out this run-out in the final tire. It would have been obvious to adopt such further processing to improve uniformity in the final tire and this would therefore render obvious a method consistent with this newly claimed language in claim 1 .

5. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over EP 448,407 to Yamakawa et al. taken in view of Okada et al. (US 2001/0002608) and at least one of [Tanaka et al. (US 6,514,441 - newly applied) and Sakamoto et al. (US 5,882,452 - newly cited)] as applied to claim 1 above, and further in view of at least one of [Akiyama (US 6,475,319) and Ikeda et al. (US 2002/0074077)] as applied in the last office action.

6. Claims 1, 2, 9, 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 2002-254529 to Toyo Rubber taken in view of EP 448, 407 to Yamakawa et al. and at least one of [Tanaka et al. (US 6,514,441 - newly applied) and Sakamoto et al. (US 5,882,452 - newly cited)].

JP '529 and EP '407 are applied for the same reasons as set forth in the last office action. As to the new language added to the end of claim 1, as already noted, the scope of this requirement is somewhat difficult to ascertain and compare with the prior art as it is not clear how measuring a toroidally shaped carcass band adjusts or even allows adjustment of a position as claimed. In any event, Tanaka et al. (e.g. fig. 2) and Sakamoto et al. (e.g. note block 15 in figs. 1/10/13 and especially the canceling out shown in fig. 14) each teach measuring the run-out of a green tire during tire manufacture, a green tire being a toroidally expanded carcass, and carrying out further adjustments based on this measurement to help minimize and thus cancel out this run-out in the final tire. It would have been obvious to adopt such further processing to improve uniformity in the final tire and this would therefore render obvious a method consistent with this newly claimed language in claim 1 .

7. Claims 2-5, 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 2002-254529 to Toyo Rubber taken in view of EP 448, 407 to Yamakawa et al. and at least one of [Tanaka et al. (US 6,514,441 - newly applied) and Sakamoto et al. (US 5,882,452 - newly cited)] as applied above, and further in view of Okada et al. (US 2001/0002608) as applied in the last office action.

8. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over [EP 448,407 to Yamakawa et al. taken in view of Okada et al. (US 2001/0002608) and at least one of [Tanaka et al. (US 6,514,441 - newly applied) and Sakamoto et al. (US 5,882,452 - newly cited)]] or [JP 2002-254529 to Toyo Rubber taken in view of EP 448,407 to Yamakawa and at least one of [Tanaka et al. (US 6,514,441 - newly applied)

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and Sakamoto et al. (US 5,882,452 - newly cited)] and further in view of Okada et al. (US 2001/0002608)] as applied above, and further in view of Senbokuya et al. (US 6,616,783) as applied in the last office action.

9. Claim 10 is directed to an invention not patentably distinct from claim 1 of commonly assigned 10/497,069 (US 2005/0142238). Specifically, as noted in the last office action, the requirement of claim 10 seems to be essentially identically disclosed in this conflicting application, the remainder of the claim (i.e., claim 1) being obvious in view of the cited art for the reasons already described.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned 10/497,069, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

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10. Claim 10 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/497,069 in view of the prior art as applied against claim 1 in this and the previous office action. Specifically, as noted in the last office action, the requirement of claim 10 seems to be essentially identically disclosed in this conflicting application, the remainder of the claim (i.e., claim 1) being obvious in view of the cited art for the reasons already described.

This is a provisional obviousness-type double patenting rejection.

11. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

12. Applicant's arguments filed 2/1/2010 have been fully considered but they are not persuasive as regards the remaining rejections. The 35 USC 112 rejections not repeated have however been overcome - note also new 35 USC 112 rejections.



The arguments with respect to the prior art rejections stress the new language added to claim 1. These arguments are however moot in view of the new grounds of rejection added to address these new limitations. The previous prior art rejection of claim 1 has been withdrawn with the filing of the translation of the priority document showing entitlement to the priority date. The obviousness double patenting and advisory information with respect to commonly assigned 10/497,069 (US 2005/0142238) are maintained.

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Geoffrey L. Knable whose telephone number is 571-272-1220. The examiner can normally be reached on M-F.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on 571-272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Geoffrey L. Knable/  
Primary Examiner, Art Unit 1791

G. Knable  
May 24, 2010